

**REMARKS**

**STATUS OF THE CLAIMS**

Claims 1 and 3-30 are pending in this application. The Examiner has indicated that claims 1, 3-8, and 10-25 are allowable. Claims 2, 26, and 27 have been canceled without prejudice or disclaimer. Claim 9 has been rejoined and stands rejected. Claim 9 has been amended, while claims 28-30 are new.

Applicants appreciated the opportunity of a telephone interview with the Examiner on March 31, 2006, to discuss the amendment to claim 9 and new claims 28-30. Applicants respectfully submit that claims 9 and 28-30 are fully enabled, in conformance with the Examiner's suggestions and are thus in condition for allowance.

In accord with the Examiner's suggestion (see *Office Action* at pp. 7-8), claim 9 has been amended to recite treating specific diseases. These diseases include the three species of claim 27 found to be acceptable by the Examiner (inflammatory disease, allograft rejection, reperfusion injury), and a specific disease within each of the claim 27 species "autoimmune diseases" and "tumor metastasis." (See *Id.*) Accordingly, Applicants select "autoimmune diabetes" and "lymphoma metastasis." Support for inflammatory disease, allograft rejection, and reperfusion injury can be found at least at p. 4, lines 3-6, of the specification. Support for autoimmune diabetes can be found, e.g., on p. 117, lines 13-15, of the specification. Support for lymphoma metastasis can be found, e.g., on p. 119, lines 18-20, of the specification. Accordingly, no new matter has been added by this amendment.

New claim 28 recites a method for treating a disease or disorder in a mammal that benefits from inhibiting the interaction of LFA-1 with ICAM-1 or ICAM-3 and that inhibits inflammation. Support for this claim can be found at least at p. 3, line 19, to p. 4, line 6, of the specification. In addition, Applicants note that the Examiner admits that the specification enables treating “diseases that benefit from the inhibition of cell adhesion.” (*Office Action* at p. 3) The method comprises administering a therapeutic amount of a compound of claim 1. Support for the efficacy of the claimed compounds of formula 1 in inhibiting the interaction of LFA-1 with ICAM-1 can be found in the biochemical assays of Example 97 at p. 113, line 18, to p. 116, line 8, of the specification.

New claim 29 is directed to a method of inhibiting the interaction of LFA-1 with ICAM-1 or ICAM-3 comprising administering an effective amount of a compound according to claim 1, wherein the administering inhibits inflammation. Support for this claim is also found in the biochemical assays of Example 97 at p. 113, line 18, to p. 116, line 8, of the specification.

New claim 30 also recites a method for treating specific diseases, similar to the acceptable amendment suggested by the Examiner for claim 9. (See *Office Action* at pp. 7-8.) This claim recites specific diseases as found at p. 116, line 10, to p. 119, line 20, of the specification. Accordingly, no new matter has been introduced in claims 28-30.

Applicants acknowledge and appreciate the Examiner’s withdrawal of the following rejections and objections:

1. Rejection of claims 1-8 and 10-25 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite;
2. Rejection of claims 1, 8, 10, 13, 16, and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,900,571; and
3. Objection to claims 2-7, 11, 12, 14, 15, 17-20, and 22-25 for depending upon a rejected base claim.

#### **REJECTION UNDER 35 U.S.C. § 112, 1<sup>ST</sup> PARAGRAPH**

The Examiner has rejected claims 9, 26 and 27 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as not being fully enabled. (*Office Action* at p. 3.) While the Examiner admits that the specification does enable treatment of diseases benefiting from the inhibition of cell adhesion, the Examiner alleges that the present disclosure does not enable treating all the diseases and disorders encompassed by claim 9. (*Id.*)

While Applicants disagree with the position of the Examiner regarding the enablement of the rejected claims, to advance prosecution, Applicants have amended claim 9 in accord with the Examiner's suggestion to recite the specific diseases of claim 27. Furthermore, while disagreeing with the Examiner's rejection, Applicants have cancelled method claims 26 and 27 without prejudice or disclaimer to advance prosecution.

As discussed above, new claims 28 and 29 find full support in the specification. Both method claims 28 and 29 are supported by the disclosure of the inhibition of the interaction of LFA-1 with ICAM-1 or ICAM-3 by the compounds of the invention. (*Specification* at p. 3, line 19, to p. 4, line 6, and at p. 113, line 18, to p. 116, line 8.) In

addition, by inhibiting this interaction, both methods result in the inhibition of inflammation as described at p. 3, lines 15-22, of the specification. Method of treatment claim 28 is further supported by the cited literature at p. 116, line 10, to p. 119, line 20, of the specification, which provides methods to determine whether a disease or disorder is benefited from the administration of a compound of the invention. Thus, Applicants respectfully submit that claims 9 and 28-30 are fully enabled by the present specification.

Applicants respectfully submit that the specification thus provides the skilled artisan with the requisite guidance to determine an effective compound for treating a disease or disorder as claimed. Such guidance, coupled with the knowledge in the art, have been shown to be sufficient evidence of enablement. *In re Wands*, 858 F.2d 731, 740 (Fed. Cir. 1988). Therefore, the specification enables one of ordinary skill in the art to make and use the claimed invention through routine experimentation.

Accordingly, Applicants respectfully request withdrawal of this rejection.

## **CONCLUSION**

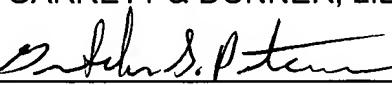
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge  
any extension fees and any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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